

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested.

Claims 21-38 were in the application, claims 26 and 36 have been amended.

Claims 26 and 36 were amended to correct the errors pointed out by the examiner, and the rejection of claims 26 and 36 under 35 U.S.C. §112 has been rendered moot.

Claims 21-38 were rejected as being anticipated by Fulton, U.S. Patent No. 6,182,052.

The applicant respectfully traverses the examiner's grounds for rejection.

The Federal Circuit has consistently held that anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. In re Bond, 910 F.2d 831 (Fed. Cir. 1990); Atlas Powder Co. v. E.I. Port de Nemours & Co., 750 F.2d 1569 (Fed. Cir. 1984). The Federal Circuit has also stated that "even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling." In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985) (citing In re Borst, 345 F.2d 851, 855 (C.C.P.A. 1965, cert. denied, 382 U.S. 973 (1966), Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 555 (1870) (publication constitutes anticipation only if it enables one skilled in the art "to understand the nature and operation of the invention, and to carry it into practical use,")).

Fulton does not anticipate any claim of the present application. The examiner's references to portions of Fulton simply do not support the examiner's argument, and amount to no more than speculative assertions that the substance of applicant's claims are found in Fulton.

Anticipation requires absolute identity between the element in the claim relative to the disclosure in the cited reference, without interposing an interpretation that does not correlate with the disclosure in the application.

Claim 21 requires each electronic space to be configured for computer based display "as a

virtual room” and means to configure “an individualized room” by selecting graphic, textual and application information and measures displayed as selectable iconic images located in the individualized room. The word “room” is not ambiguous and is consistently used throughout the application with its conventional meaning. A “room” is “a partitioned part of the inside of a building” Webster’s Dictionary, Exh. A.

This is what is shown in the applicant’s Fig. 2 quite clearly. A “virtual room” truly means having the appearance of a room, i.e., a partitioned part of the inside of a building, that is created and decorated by the user. The examiner has ignored the applicant’s description, as well as the words chosen to define the invention. Quite simply no such virtual room is found in Fulton, and absent such a room, there can be no anticipation.

There is no correspondence between “creating user friendly terminals using touch screens”, cited by the examiner and the virtual room of applicant’s invention. Fulton has a touch screen with buttons. Reviewing Fig. 2-13 of Fulton shows no display that could reasonably be considered to be a “virtual room”, and the examiner has, in essence, written the virtual room out of the claim.

Similarly, there is no correspondence between the means for each user to configure an individualized “room” which the examiner has found in the “recording user input data including user choice selections”. The choices have nothing to do with creating an individualized “room”, since there is no “room” to begin with.

Similarly, there are no uses of selectable iconic images in Fulton and this element is also absent.

The entire system of Fulton bears no relationship to the applicant’s invention and cannot render the claims anticipated. Anticipation requires the reference to be enabling. One skilled in

the art must be enabled to practice the claimed invention, defined by the words of the claim, not the examiner's edited version of the claims, with critical words omitted or not given even their ordinary meaning. One skilled in the art would understand that there are no "virtual" displays in Fulton and nothing in the nature of virtual reality ever discussed. The Fulton patent consequently does not enable one to make or use the applicant's invention.

As to claim 26, it is not credible to consider item 11 in Fig. 1 as "a computer generated image of a room". This simply shows a telephone. A telephone is not a "room" by any stretch of the imagination. There certainly are no selected "decorative" images or selected "furnishing" images, and the examiner's assertions go well beyond speculative. There is simply no support for the examiner's position.

Anticipation requires a strict identity, without guessing what the reference discloses and clearly claims 21-38 are not anticipated by Fulton. In Dayco Products, Inc. V. Total Containment Inc., 329 F.3d 1358 (Fed. Cir. 2003), the Federal Circuit overruled an anticipation finding that a "polymeric" hose was found in the prior art stating:


On appeal, TCI admits that the reference fails to expressly state that the hose 18 of Lusher is a polymeric hose. Instead, TCI asserts that "it is inherent from Figure 2 that the inner corrugated hose was made from a synthetic (i.e. polymeric) material." (Appellee's Br. at 44). There is no support on the record before us for the proposition that Lusher (filed September 27, 1939), necessarily disclosed the use of a polymeric material. "To serve [*29] as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be

filled with recourse to extrinsic evidence[; however,s]uch evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.” Cont’l Can Co. USA v. Monsato Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). TCI has cited to no evidence that this missing element was necessarily present.

Similarly here, a “virtual room” is not mentioned in the reference, nor is it inherent that such a room would be “necessarily present” and the anticipation rejection must be withdrawn.

Based on the above amendments and remarks, favorable consideration and allowance of the application is requested. However should the examiner believe that direct contact with the applicant’s attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,


William J. Sapone
Registration No. 32,518
Attorney for Applicant(s)

Coleman Sudol Sapone P.C.
714 Colorado Avenue
Bridgeport, CT 06605
Telephone No. (203) 366-3560
Facsimile No. (203) 335-6779